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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,766	01/02/2002	Jeffery Tabor	659/919	6310
7590	06/09/2005		EXAMINER	
Robert N. Carpenter BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			PURVIS, SUE A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/038,766	TABOR ET AL.
	Examiner Sue A. Purvis	Art Unit 1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 March 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2,3,6-8 and 15-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 2,3,6-8 and 17-21 is/are allowed.
 6) Claim(s) 15, 16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuntze et al. (US Patent No. 6,620,276 B1).

Kuntze discloses an apparatus for applying discrete parts onto a substrate web, the apparatus includes a transfer assembly (60) configured to rotate about an axis and which includes an outer surface configured to engage the discrete parts, and a web conveyor having an outer surface adapted to support and advance a substrate web, with the outer surface of the web conveyor including at least one recessed portion having a bottom surface capable of accommodating the discrete parts. (See Figures 2 & 4.)

Regarding claim 16, the web conveyor is spaced from the transfer assembly a distance less than the combined total thickness of the substrate web and the discrete part.

3. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Blomqvist et al. (US Patent No. 3,847,710).

Blomqvist discloses an apparatus with a carrier body having a discrete part engaging outer surface, the outer surface including a generally convex surface and a generally convex recessed portion (3) spaced inwardly. The surface is adapted and configured to engage a discrete part having a thickness. The recessed portion having a bottom surface adapted and configured to engage the discrete part and further comprising at least one aperture (4) in the outer surface and extending through the carrier body for communication with a vacuum source. The carrier body is rotatable about an axis normal to the convex surface.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura et al. (US Patent No. 4,941,939) in view of Tomsovic, Jr. (US Patent No. 4,726,876) or Oshefsky et al. (US Patent No. 4,617,082).

Nomura discloses an apparatus for applying discrete parts onto a substrate web, the apparatus includes at least one transfer assembly configured (not detailed) which transfers the discrete parts to a web. Nomura also includes a web conveyor (1) having an outer surface adapted to support and advance a substrate web, with the outer surface of the web

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conveyor including at least one recessed portion having a bottom surface capable of accommodating at least one portion of each of the discrete parts that is relatively thicker than other portions of each of the discrete parts. (Col. 4, lines 7-54.)

Nomura does not detail a transfer assembly configured to rotate about an axis.

Nomura does suggest that particular types of this device are not critical so long as the device functions in the manner mentioned above in that it applies the substrate to the web.

A well-known type of transfer member is a rotating one as seen in Tomsovic, Jr. or in Oshefsky.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a rotating transfer roll in the device of Nomura to place the discrete part on the web, because a rotating transfer roll is a well known method of transferring parts and Nomura suggests particular features of the device are not important, only that it transfers the substrate to the web.

Regarding claim 16, it is within the purview of the artisan to have the web conveyor spaced from the transfer assembly a distance less than the combined total thickness of the substrate web and the discrete part.

Response to Arguments

6. Applicant's arguments filed 21 March 2005 have been fully considered but they are not persuasive.

7. Applicant argues that Kuntze does not disclose "at least one recessed portion having a bottom surface for accommodating at least one portion of each of the discrete parts that is relatively thicker than the other portions of each of the discrete parts," the examiner disagrees. This limitation is present in Kuntze as clearly shown in Figure 2 with the linking means (40) and the web loops (101) in Figure 4. This rejection stands.

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8. Regarding applicant's arguments with respect to Nomura on page 6 of their response, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

9. Furthermore, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). (See MPEP §2115.) Thus applicant's arguments regarding the discrete portions in Nomura does not dissuade the examiner from maintaining the rejection.

Allowable Subject Matter

10. Claims 2, 3, 6-8, and 17-21 are allowed.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
June 6, 2005